

## **REMARKS**

Claims 31-52 were pending before entry of the present amendment. Claims 31-39, and 42 have been amended to more particularly point out and distinctly claim the subject which the Applicants regard as their invention or correct claim dependencies based on the present amendments. Claim 35 has been canceled without prejudice. New claims 67-73 have been added which are fully supported by the instant application, *see, e.g.*, the instant specification at p. 13, paragraph 28; p. 16, paragraph 40; pp. 18-19, paragraph 45. Accordingly, no new matter has been introduced.

After entry of this amendment claims 31-52, and 67-73 will be pending in the instant application.

### **1. THE REJECTION UNDER 35 U.S.C. § 102(b) SHOULD BE WITHDRAWN**

Claim 31 is rejected under 35 U.S.C. §102 (b) as anticipated by U.S. Patent No. 6,656,147 to Gertsek et al. ("Gertsek").<sup>1</sup> The Examiner contends that Gertsek disclosed a delivery device for the transdermal administration of a substance. However, based on its issue and filing date (issued on December 2, 2003 and filed on July 17, 2000), Gertsek would appear to be available only under 35 U.S.C. §102(e). Without addressing the merits of the Examiner's rejection, Gertsek shares a common inventor (Ronald J. Pettis) with the instant application and was assigned to the same assignee (Becton, Dickinson and Company, Inc.) and as such must be disqualified as prior art against the claimed invention under 35 U.S.C. §102(e).

Accordingly, reconsideration and withdrawal of the rejection under 35 U.S.C. § 102(b) is respectfully requested.

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<sup>1</sup> On p.2 of the Office Action, the Examiner rejects claim 1 under 35 U.S.C. § 102(b), however, since claim 1 has been withdrawn from consideration pursuant to the Examiner's Restriction Requirement, we are addressing the rejection in view of Claim 31, which is under consideration.

2. **THE REJECTION UNDER 35 U.S.C. § 103 (a) SHOULD BE WITHDRAWN**

Claims 32-52 are rejected under 35 U.S.C. 103(a) as unpatentable over Gerstek in view of U.S. Patent No. 6,689,103 to Palasis et al., ("Palasis") and U.S. Patent No. 6,537,242 to Palmer et al., ("Palmer").

Without addressing the merits of the rejection, Applicants note that Gertsek and Palmer should properly be disqualified as prior art against the claimed invention as the subject matter and the claimed invention were at the time the invention was made, subject to an obligation of assignment to the same person pursuant to *M.P.E.P.* § 706.01(l)(1). U.S. Patent Application No. 10/028,988 ("the '988 application") and U.S. Patent Nos. 6,656,147 and 6,537,242 were at the time the invention of the '988 application was made owned by Becton, Dickinson and Company, Inc.

As further objective evidence of common ownership, the reel and frame numbers for the recorded assignment for the '988 application are **013947/0702** recorded on **September 5, 2003** and the reel and frame numbers for the '147 and 242 patents are **010948/0523** recorded on **July 17, 2000**; and **010870/0277** recorded on **June 6, 2000**, respectively.

Entry of the foregoing amendments and consideration of the remarks is respectfully requested. The claims are believed to be patentable and free of the art. Early allowance is respectfully requested.

Date February 2, 2005

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